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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,631	08/05/2003	Hiroyuki Kusaka	026304-0208	8454
23392	7590	05/11/2004	EXAMINER	
FOLEY & LARDNER 2029 CENTURY PARK EAST SUITE 3500 LOS ANGELES, CA 90067			NGUYEN, PHUONGCHI T	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,631

Applicant(s)

KUSAKA, HIROYUKI

Examiner

Phuongchi Nguyen

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AW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Chin et al (US6670950B1).

In regarding to claim 1, Chin et al discloses an electronic apparatus (figure 4), comprising housing (44) having outside wall (of 44) which has an outer surface (top surface) exposed outward the housing (44), and an operation area (48) in the outer surface (top surface); and a pointing device (touch screen 48a) having a flat input surface (of 48b) (figure 7) laid on the inner surface operation area (48), the flat input surface (of 48b) receiving input operations through the operation area (48).

In regarding to claim 2, Chin et al discloses the electronic apparatus wherein the operation area (48) has a recess (where 48a located) formed on the outer surface (of 48) (figure 7).

3. Claim 1, 3, and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Iredale (US6392877B1)

In regarding to claim 1, Iredale discloses an electronic apparatus (figure 1), comprising housing (of 24) having outside wall which has an outer surface (34) exposed outward the housing (of 24), and an operation area (of 50) in the outer surface (34); and a pointing device (50) having a flat input surface (it is inherent) (figure 2) laid on the inner surface operation area

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(of 50), the flat input surface receiving input operations (it is inherent, otherwise the touch pads 50 will not be able to operate) through the operation area (of 50).

In regarding to claim 3, Iredale discloses the electronic apparatus wherein the operation area (of 50) has projection formed on the outer surface (34) (figure 3).

In regarding to claim 8, Iredale discloses the electronic apparatus wherein the operation area (of 50) has a plurality of recesses (where 50 and two other projections 50 located as seen in figure 3) provided therein.

In regarding to claim 9, Iredale discloses the electronic apparatus wherein the operation area (of 50) has plurality of projections (50, 50, 50) provided therein (figures 1 and 3).

4. Claim 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenberg et al (US6429846B2).

In regarding to claim 1, Rosenberg et al discloses an electronic apparatus (figure 1), comprising housing (of 10) having outside wall which has an outer surface (top surface adjacent 16) exposed outward the housing (of 10), and an operation area (of 16, 26) in the outer surface (top surface); and a pointing device (16) having a flat input surface (it is inherent) (figure 2) laid on the inner surface operation area (of 16, 26), the flat input surface receiving input operations (it is inherent, otherwise the touch pads 50 will not be able to operate) (figure 6) through the operation area (of 16, 26).

In regarding to claim 10, Rosenberg et al discloses (figure 1) the electronic apparatus wherein the operation area (of 16, 26) has a first operation area (16) for first operation, and second operation area (26) provided separately from the first operation area (16) for second operation.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al (US6670950B1) in view of Chiang (US5973622).

In regarding to claim 4, Chin et al discloses the invention, but lacks a sticker. However, Chaing teaches an electronic apparatus comprising a sticker that stuck to the operation area (column 1, lines 43-44). It would have been obvious to one having ordinary skill at the time the invention was made to modify the apparatus of Chin et al by providing a sticker as taught by Chaing to hold the touch screen and the flat input surface when a user moves a pointer on the screen.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al (US6670950B1) in view of Applicant Admit over Prior Art (AAPA).

In regarding to claim 5, Chin et al discloses the invention, but lacks a painted layer. However, AAPA teaches the operation area is a color LCD display (column 2, lines 8-9 and 42). It would have been obvious to one having ordinary skill at the time the invention was made to modify the operation area of Chin et al by having a painted layer as taught by AAPA for displaying the good images on the screen.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al (US6670950B1) in view of Mohi et al (US6377456B1).

In regarding to claims 6 and 7, Chin et al discloses the invention, but lacks a surface roughness or mesh portion. However, Mohi et al teaches the area (36) is made with surface roughness or mesh different from a surrounding area (figure 1). It would have been obvious to

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one having ordinary skill at the time the invention was made to modify the operation area of Chin et al by having a surface roughness or mesh portion as taught by Mohi et al for distinguish the operation area from the neighbor areas.

9. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iredale (US6392877B1) in view of Applicant Admit over Prior Art (AAPA) and Sung (US6587231B1).

In regarding to claim 11, Iredale discloses the invention, but lacks a housing having a transparent outside wall and a painted layer. However, Sung teaches a housing (1) is a transparent housing (Column 2, lines 35) and AAPA teaches the operation area is a color LCD display (column 2, lines 8-9 and 42). It would have been obvious to one having ordinary skill at the time the invention was made to modify the housing of Chin et al by having a transparent housing as taught by Sung for having a light weight and decoration; and to modify the operation area of Chin et al by having a painted layer as taught by AAPA for displaying the good images on the screen.

Claim 12 is rejected for the same reason of claim 3.

In regarding to claim 13, Iredale discloses the electronic apparatus wherein the operation area (of 50) has recess (opening on 34 for 50 located) formed on the outer surface (34).

In regarding to claim 14, Iredale discloses the electronic apparatus wherein the outer surface (34) has a palm rest (54, 56) in which the operation area (of 50) is provided (figure 1).

In regarding to claim 15, Iredale discloses the electronic apparatus wherein the housing (of 24) is made of a resin (it is inherent).

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Tonar et al (US6700692B2) is cited to show the opaque layer.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchi Nguyen whose telephone number is (571) 272-2012. The examiner can normally be reached on 8:00AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PCN

April 21, 2004


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